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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/387,452	09/01/1999	NICHOLAS R. DONO	Y0999-294(87	2592

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EXAMINER
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KLIMACH, PAULA W

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 01/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/387,452

Applicant(s)

DONO ET AL.

Examiner

Paula W Klimach

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

This office action is in response to amendment filed on 10/20/03 (Paper No. 5). Original application contained Claims 1-22. Applicants also have made the appropriate adjustment to Claims 1, 7, 9, 11, 13, 15-16, 20, and 22 to overcome 112 rejection as identified in previous office action (Paper No. 4). The amendment filed on 10/20/03 have been entered and made of record. Therefore, presently pending claims are 1-22.

### ***Response to Arguments***

Applicant's arguments filed 10/20/03 have been fully considered but they are not persuasive because of following reasons.

Applicant argued that Jones does not teach the storage device having stored therein an access code for indicating whether an individual is authorized to temporarily access the CA computer. This is not found persuasive. Kawagishi discloses a system where the access code is stored on an IC card that is used to gain temporary access to a host computer.

Applicants clearly have failed to explicitly identify specific claim limitations, which would define a patentable distinction over prior arts.

Applicant argued further that Jones, Barritz, and Peterson are not analogous art and are not properly combined. This is not persuasive because Kawagishi, Barritz, and Peterson are reference that deal with the use of computers by a user and making the computer available to the user by in the case of Kawagishi, authenticating the user and then providing access; in the case of Barritz, personalizing the computer therefore making it easier for the user to use and therefore

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providing access; in the case of Peterson, billing the user that was, in this combination, authorized by Kawagishi to access the computer.

The examiner asserts that prior does teach or suggest the subject matter broadly recited in independent Claims 1, 11, 16. Dependent Claims 2-10, 12-15, and 17-22 are also rejected at least by virtue of their dependency on independent claims and by other reason set forth in this office action (Paper No. 6). Accordingly, rejections for claims 1-22 are respectfully maintained.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-4, 6-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawagishi (JP 07200481 A) in view of Barritz (EP 0 854 421 A1) and further in view of Peterson (6,349,289 B1).

3. *In reference to claims 1, 11, and 16*, Kawagishi discloses a method for providing an individual temporary access to a commonly accessible computer processing system (CA computer) the CA computer, host computer, obviously having a plurality of application programs associated therewith the method comprising the steps of: detecting the coupling of a portable storage device to the CA computer the storage device having stored therein an access code for indicating whether the user is authorized to temporarily access the CA computer and

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information. The system determines whether the individual is authorized to temporarily access the CA computer, based on the access code (Basic-Abstract).

Kawagishi does not disclose the computer information comprising computing preferences of the individual, which modify the CA computer in accordance with the information stored in the storage device and providing temporary access to the CA computer, when the individual is authorized to temporarily access the CA computer; monitoring the activity of at least one of the individual and the CA computer, until the storage device is de-coupled from the CA computer; generating a bill based on said monitoring; and automatically providing the bill to a predetermined billing mechanism.

Barritz discloses a system for gathering information to personalize computers available for public use (abstract).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to employ the teachings of gathering information to personalize the host computer disclosed by Barritz within the system disclosed by Kawagishi. One of ordinary skill in the art would have been motivated to do this because using walk-up computers effectively requires \_\_\_\_\_ certain configuration settings and user-related information must be established (Barritz column 1 lines 35-45).

The combination of Kawagishi and Barritz teaches all the limitations except monitoring the activity of at least one of the individual and the CA computer, until the storage device is de-coupled from the CA computer; generating a bill based on the monitoring; and automatically providing the bill to a predetermined billing mechanism

Peterson discloses a system for monitoring the activity of at least one of the individual and the CA computer, until the storage device is de-coupled from the CA computer; generating a bill based on said monitoring; and automatically providing the bill to a predetermined billing mechanism (abstract in combination with column 3 line 45 to column 4 line 12).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to employ the teachings of Peterson within the combination of Kawagishi and Barritz. One of ordinary skill in the art would have been motivated to do this because it is advantageous to consolidate usage and billing information in a single report and manipulate it for each of a number of different host computer networks by an individual user and by predetermined groups or departments of users (Peterson column 1 lines 48-57).

4. *In reference to claims 2 and 17*, Peterson generates the bill by generating an activity log based on said monitoring and converting the activity log into the bill (abstract).

5. *In reference to claims 3, 12, and 18*, Kawagishi further suggests inhibiting temporary access to the CA computer, when the individual is not authorized to access the CA computer (Basic-Abstract). The host computer only permits access only when presented with the access code in the IC card.

6. *In reference to claim 4*, the portable storage device comprises a PCMCIA card (Kawagishi, Basic-Abstract).

7. *In reference to claims 6 and 19*, the predetermined billing mechanism disclosed by Peterson suggests that it is associated with one of a user account and a credit card (Peterson column 1 lines 58-67).

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8. *In reference to claims 7-9, 13-15, and 20-22*, the access code disclosed by Kawagishi that is stored in the storage device further indicates whether the user is authorized to temporarily use any of the plurality of application programs associated with the CA computer, and which of the plurality of application programs such authorization is provided thereto where the system determines whether the individual is authorized to temporarily use any of the plurality of application programs associated with the CA computer, based on the access code; and provides temporary access to the application programs associated with the CA computer for which authorization is indicated, when the individual is authorized to temporarily use any of the plurality of application programs associated with the CA computer (Kawagishi, Basic-abstract). The user only attains access to the host computer with the access code that is stored on the IC card, it is inherent that the programs available on the host computer will only be available if the user attains access.

9. *In reference to claim 10*, Kawagishi further suggests the step of providing the individual with a user account by writing the access code to the portable storage device, before said step of determining whether the individual is authorized to temporarily access the CA computer (Basic-abstract). The user attains access to the host system when the access code is as stored in the host system therefore the account is inherently created before access is given.

10. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawagishi, Barritz and Peterson as applied to claim 1 above, and further in view of the Microsoft Computer dictionary.

Kawagishi does not expressly disclose the PCMCIA card having flash memory.

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The Microsoft Computer dictionary discloses flash memory being available as a PC Card plugged into a PCMCIA slot (page 199).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use flash memory as disclosed in the Microsoft computer dictionary in the PCMCIA card disclosed by Kawagishi. One of ordinary skill in the art would have been motivated to do this because this is commonly done (Microsoft page 199).

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paula W Klimach whose telephone number is (703) 305-8421. The examiner can normally be reached on Mon to Fri 7:15 a.m to 3:45 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (703) 305-9648. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-8421 for regular communications and (703) 305-8421 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4832.

PWK  
January 12, 2004



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